

## c.) Remarks:

Reconsideration of this application as amended is respectfully requested.

Applicant respectfully traverses the double patenting rejection. The double patenting is asserted to involve claims 1, 3, and 4 of this application and claims 1, 7, and 8 of applicant's patent No. 6,651,384 which issued on the parent of the present application. As is stated in § 804 of the Manual of Patent Examining Procedure, the doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The possibility of extension is not present in this case because the present application is a continuation of the application which matured into patent No. 6,651,384 and, accordingly, will expire on the same date as the date of expiration of such patent. Accordingly, there is no possibility of extending exclusivity beyond the term of the '384 patent.

In addition to the foregoing, claim 1 of the '384 patent specifies that the thickness of the material containing the indexing apertures is greater than that of the thinner zones of said sheet, and prior to the forming of said tray. No corresponding limitation appears in any of claims 1, 3, or 4 of the present application. Since each of claims 7 and 8 of the '384 patent depends on claim 1, such limitation is present in all three of the patent's claims. Since claims 3 and 4 of the present application depend on claim 1, and since claims 3 and 4 do not include the limitation referred to in claim 1 of the '384 patent, it is respectfully submitted that no double patenting is

involved in the present case. Accordingly, reconsideration and withdrawal of the double patenting rejection are requested.

Another pertinent matter involving the double patenting rejection is that claims 3 and 4 of the present application recite stiffening ribs. There are no ribs recited in claims 1, 7, or 8 of the patent. Claims 7 and 8 do recite stiffening flanges, but they are not the same as or the equivalent of the stiffening ribs.

The rejection of claims 1, 5, and 19 as being unpatentable over Nicholson in view of Araki et al (Araki) is respectfully traversed. It is understood that the examiner considers the flange 18 of Nicholson to constitute a thicker zone having indexing apertures therein. Applicant believes the examiner's view of Araki is that it discloses marginal flanges 7 having indexing apertures 8 therein. It does not appear that the flanges 7 of Araki are in zones that are thicker than other parts of the tray.

The examiner recognizes that claim 1 requires the open tops of the cells to be substantially coplanar with the upper surfaces of the thicker zones in which the indexing apertures are formed. The examiner apparently relies upon Araki for a disclosure of marginal flanges having indexing apertures therein which are substantially coplanar with the open tops of the cells.

If the teachings of Araki were to be applied to the Nicholson disclosure in the manner proposed by the examiner, the flanges 18 of Nicholson would have to be relocated upwardly so that the upper surfaces thereof are substantially coplanar with the open tops of the cells. This,

however, would make it impossible for the (lower) free edges of the flanges 18 to support the tray at such level that the bottoms 14 of the cells 11 are spaced above the supporting surface. However, the ability of the flanges 18 to support the tray in such manner that the bottoms of the cells are at a level above that of the supporting surface is a very important characteristic of the Nicholson construction. In support of this observation reference is made to column 2, lines 34-38 wherein it is stated:

The bottoms 14 of cells 11 are raised above the lower edge of sidewalls 18 by about three quarters of an inch to provide an air circulation chamber 20 when the tray is in use, resting on a substantially flat surface.

The significance of supporting the bottoms of the cells 11 above a supporting surface so as to provide the air circulation chamber 20 is explained by Nicholson in column 2, lines 63-69, as follows:

The resulting maximized air circulation in chamber 20 dries the seedling roots that grow out the drain holes 16, causing them to fall off in a self pruning process. Hence, when the seedling is ejected by a machine operated plunger, there are no roots ripped off because they are wrapped around the bottom 14 of the cells 11.

It is respectfully submitted that rearranging the flanges 18 of Nicholson in such manner as to enable the upper surface thereof to be substantially coplanar with the open tops of the cells would be in direct conflict with the express teachings of Nicholson in that it then would not be possible for the bottoms of the cells to be supported above the level of a supporting surface and provide the air circulating chamber 20. Such modification of Nicholson, therefore, would make it impossible for the Nicholson construction to function in the manner intended by the patentee.

It long has been a principle of patent law that it is neither obvious nor proper to modify a reference in such manner as to prevent its operating in the manner intended by the patentee. See, for example, Ex parte Westphalen reported at 159 USPQ 507. Further, if modification of a reference would prevent its operating in the manner intended by the patentee, there obviously can be no motivation to a person of ordinary skill in the art to make such modification. In the absence of some motivation for the proposed modification, it is more than likely that the suggestion for the modification is the result of hindsight derived from applicant's own disclosure. Hindsight modification of a reference is improper and not obvious.

Another reason that the proposed modification of Nicholson is inappropriate is because such modification then would make it impossible for the flanges 18 of Nicholson, which are shown as depending and slanting, to enable multiple trays to be stacked in nested relation. This, too, is a specifically stated purpose of the Nicholson construction. See column 2, lines 32-34.

It is respectfully submitted that the proposed modification of Nicholson in view of Araki is neither proper nor obvious inasmuch as such modification would be directly contrary to Nicholson's specific teachings and render the modified Nicholson apparatus incapable of functioning in at least two specific ways intended by the patentee. Under the circumstances, it is respectfully submitted that the rejection of claim 1 should be reconsidered and withdrawn.

Claim 5 depends on claim 1 and, accordingly, distinguishes over Nicholson and Araki in the same manner set forth in connection with the parent claim. Claim 5 distinguishes over claim 1 by reciting other characteristics of applicant's construction.

Claim 19 recites the thicker and thinner defined zones in the nursery tray, a flange at opposite edges of the tray, and specifies that each flange has a first section formed by one of the thicker zones and a stiffening second section depending from the first section. The claim also recites a plurality of rows of spaced apart open top cells located between the first sections of the flanges, with the open tops of the cells and the upper surfaces of the thicker zones being substantially coplanar. Finally, the claim recites a row of aligned spaced apart indexing apertures in the first section of each of the flanges and extending through the upper surface thereof. Since the upper surfaces of the first sections of the flanges are coplanar with the open top of the cells and since the first flange sections are those in which the indexing apertures are located, claim 19 patentably distinguishes over the references for the reasons given in support of claim 1.

The rejection of claims 3, 4, and 13-15 as being unpatentable over Nicholson in view of Araki and Kuben also is respectfully traversed. These claims depend, ultimately, on claim 1 and, therefore, distinguish over the Nicholson and Araki references for the same reasons given in support of claim 1. The examiner takes the position that Kuben discloses stiffening ribs between cells. However, Kuben relates to a base plate for transporting and cultivating plants in pots with apertures in the plate for receiving the

plant pots. This is a wholly different type of product from the nursery tray recited in the claims under consideration and which has rows of spaced apart open top cells rather than mere apertures or receptacles designed to hold plant pots. It may be that a plastic base plate having apertures or cavities for holding relatively heavy plant pots requires stiffening ribs, but it is respectfully submitted it would not be obvious to a person of ordinary skill in the art that a nursery tray having open top cells would require stiffening ribs or bridging material between at least some of the cells as is recited in the claims under consideration. Furthermore, nothing in Kuben either discloses or suggests the structural shortcomings of Nicholson and Araki which already have been discussed at length. Accordingly, it is respectfully submitted that claims 3, 4, and 13-15 also are allowable.

Claim 15 has been amended in a manner which it is believed overcomes the examiner's objection.

The rejection of claim 2 as being unpatentable over Nicholson and Araki in view of Boodley et al (Boodley) also is respectfully traversed. Since claim 2 depends on claim 1 it distinguishes over Nicholson and Araki for the reasons stated above. Boodley has been relied upon for its disclosure of apertures which are described by the patentee as air holes. The examiner has expressed the view that such air holes could function as indexing apertures. However, another long-standing principle of patent law is that even though prior art could be modified to conform to a claimed construction, the modification cannot be obvious unless the prior art suggests the desirability of such modification. In re Laskowski, 10 USPQ2d

1397. No such suggestion appears in the cited prior art. Accordingly, claim 2 is respectfully submitted to be allowable.

Newly presented claim 20 is based generally on claim 1, but distinguishes over the latter by specifically stating that there are a plurality of additional spaced apart, open top cells positioned outwardly of the rows of indexing apertures. Otherwise, claim 20 distinguishes over the art for the same reasons given in support of claim 1.

Newly presented claim 21 recites a nursery tray having thicker and thinner defined zones, the thicker zones having upper surfaces substantially coplanar with each other. A laterally extending flange is recited as being at opposite sides of the tray, each laterally extending flange being formed by one of the thicker zones. The claim also recites a plurality of rows of spaced apart, substantially uniform height open top cells located between the laterally extending flanges. The claim also requires the open tops of the cells to be substantially coplanar with the upper surfaces of the thicker zones, and concludes with the recitation of a row of aligned, spaced apart indexing apertures in each of the laterally extending flanges and extending through the upper surface thereof.

Claim 21 recites a construction wherein laterally extending flanges at opposite sides of the tray are formed by thicker zones thereof and have indexing apertures extending therethrough. These upper surfaces and the open tops of the cells are required to be substantially coplanar. Since the indexing apertures extend through the upper surface of the flanges, the upper ends of the indexing apertures also are coplanar with the open tops of

the cells. The coplanar arrangement of the upper surfaces of the thicker zones and the open top cells is neither shown nor suggested by Nicholson. For the reasons set forth hereinbefore the Nicholson tray cannot properly be modified as proposed, even relying on applicant's disclosure as a guide, since such modification would render the Nicholson construction unsuitable for this purpose. Claim 21, therefore, is respectfully submitted to be allowable.

Newly presented claim 22 depends on claim 21 and distinguishes over the latter by requiring each flange to be joined to a downwardly extending stiffening flange. However, each stiffening flange is required to have a height less than that of the open top cells. Consequently, the disclosure in Nicholson of depending flanges is not suggestive of the claimed construction because the depending flanges in the Nicholson construction must have a height considerably greater than that of the open top cells. Otherwise, the Nicholson apparatus cannot function as intended by the patentee.

It is believed this application now is in condition for allowance. Further and favorable action is requested.

Enclosed herewith is our check in the amount of \$200 in payment of the additional claims fee.

Also enclosed are a petition for a three month extension of time



SERIAL NO: 10/656,643

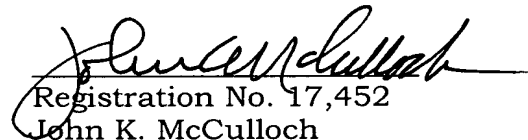
15

and our check in the amount of \$510 in payment of the extension fee.

The Office is authorized to charge or refund any fee deficiency or excess to Deposit Account No. 50-2676.

Respectfully submitted,

Geoffrey Alan Williames,  
By his attorney,



Registration No. 17,452  
John K. McCulloch  
5291 Colony Drive North  
Saginaw, Michigan 48638  
989-792-2500  
989-792-2535 facsimile

**CUSTOMER NO: 000042083**